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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/834,050	04/11/97	CHUM	P 40121BL

OSBORNE K MCKINNEY
2301 BRAZOSPORT BLVD B1211
FREEPORT TX 77541

15M1/0219

EXAMINER

WU, D

ART UNIT	PAPER NUMBER
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1505

DATE MAILED:

02/19/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/834,050

Applicant(s)

Chem et al.

Examiner

David Wu

Group Art Unit

1505



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 9-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 9-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "greater than about" of claim 18, lines 3-4 is indefinite because it has been held that the term "about" allows some flexibility. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 18 USPQ 2d. 1016, 1030 (Fed. Cir. 1991). The lower limit is unclear since the term has not yet been defined in the specification.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claims 9-31 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Lai et al. (U.S. Patent No. 5,408,004, hereinafter "Lai") or Hodgson et al. (U.S. Patent No. 5,376,439, collectively "Hodgson").

5. The Lai patent has a different inventive entity from that of the U.S. Patent No. 5,272,236. Further, a patentee cannot obtain the benefit of the filing date of an earlier application where the claims in issue could not have been made in the earlier application. It has been held that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the latter application, as required by 35 USC § 112. See *In re Chu*, 36 USPQ 2d 1089, 1093

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(CAFC 1995). Accordingly, Lai reference '004 is deemed to be a good 102(e) prior art.

6. Lai discloses polyolefin blends comprising at least 10 percent, preferably at least 30 percent of at least one linear homogeneously branched polyethylene, such as one of a Tafmer TM, Exact TM (defined in column 3, lines 43-56), and the remainder of the blend comprises one or more heterogeneously branched polyethylene (defined in column 3, lines 3-14). See column 2, lines 51-56; column 5, line 67 to column 6, line 15; column 6, line 54 to column 7, line 2; column 7, lines 23-31; examples 1-2. Although Lai fails to disclose the property such as the slope of strain hardening coefficient of the linear homogeneously branched polyethylene, in view of the same type of the polymer and made by the same technology taught by Lai reference and the instant disclosure, the Examiner has a reasonable basis to believe that Lai's linear homogeneously branched polyethylene possesses substantially the same value of the slope of strain hardening coefficient. Since the PTO does not have proper means to conduct the analytical tests, the burden of proof is now shifted to Applicants to show otherwise. *In re Best*, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

Hodgson discloses a film comprising a mixture of (a) about 30 to 90% by weight of a copolymer of ethylene and a C₄ to

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C₂₀ α -olefin comonomer having a single melting point, a density of from about 0.88 g/cm³ to about 0.91 g/cm³, a melt index of 0.5 to 7.5 dg/min., a molecular weight distribution less than 3.0 and a CBDI greater than 70%; and (b) a low density ethylene polymer having a density in the range of from about 0.91 to about 0.935 g/cm³. See patented claims. Although Hodgson fails to disclose the property such as the slope of strain hardening coefficient of the copolymer (a), in view of the same type of the copolymer and the properties reported by the reference match those specified in the instant claims, the Examiner has a reasonable basis to believe that Hodgson's copolymer (a) possesses substantially the same value of the slope of strain hardening coefficient. Since the PTO does not have proper means to conduct the analytical tests, the burden of proof is now shifted to Applicants to show otherwise. *In re Best*, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

7. Even if the properties of the polymers of the instant claims and the prior art examples are not the same, it would still have been obvious to one of ordinary skill in the art to make polymers having the claimed properties because it appears that the references generically embrace the claimed polymers and the person of ordinary skill in the art would have expected all

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embodiments of the references to work. Applicants have not demonstrated that the differences, if any, between the claimed product and the prods of the prior art examples give rise to unexpected results.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 17-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-13 of U.S. Patent No. 5,677,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter is fully disclosed in the patented claims.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Wu whose telephone number is (703)308-2450. The examiner can normally be reached on weekdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph Schofer, can be reached on (703) 308-2452. The fax phone number for this Group is (703) 305-5408.

David Wu
DAVID W. WU
PRIMARY EXAMINER
GROUP 1500

DWW
February 16, 1998